

### Remarks

This is in response to the first Office Action mailed October 14, 2005 which rejected claims 1-2, 5-8 and 11-18, and objected to claims 3-4 and 9-10.

Amendments have been presented above to independent claim 7 so as to now generally include, "wherein the point-splitting port comprises a guide feature that maintains a longitudinal length of the bit along a predetermined axial line and at a constant angular orientation with respect to said line prior to and during the point-splitting operation." Support for this includes the previous language of claim 7, as well as in the specification at page 6, lines 6-11; page 7, lines 1-10; page 7, lines 15-16 ("The [split-point] port thus allows the point to be split *using a simple push-in motion.*") (emphasis added).

This amendment is proper, does not introduce new matter or narrow the scope of the claims, and serves to place the application in proper condition for reconsideration and allowance.

### Rejection of Claims Under 35 U.S.C. §102(b)

Claims 1-2, 5-8 and 11-12 were rejected as being anticipated by co-owned U.S. Patent No. 5,735,732 issued to Bernard ("Bernard '732"). This rejection is respectfully traversed.

With regard to claim 1, Bernard '732 fails at least to disclose "a guide feature that maintains a longitudinal length of the bit along a predetermined axial line and at a predetermined angular orientation with respect to said line as said material is removed by the grinding wheel assembly."

Bernard '732 further fails at least to disclose, "using the guide feature to maintain the bit in a first orientation while removing a first portion of said material" and "using the guide feature to maintain the bit in a second orientation that is 180 degrees opposite the first orientation with respect to the axial line while removing a second portion of said material."

The basis of the rejection under §102(b) was unclear based on the mere reference to col. 7, line 43 to col. 8, line 12 and FIG. 8, so the Applicant is not adequately informed of the Examiner's rationale as to how these explicit limitations are met by Bernard '732. Nevertheless, it is clear that these referenced sections of Bernard '732 are silent with regard to the above limitations of claim 1.

Bernard '732 discloses a drill sharpener 10 with a split-point port 72 with features 114, 116 that provide an initial biasing force upon chuck 200, 300 that initially *prevents* the drill bit from touching the grinding wheel. Col. 7, line 64 to col. 8, line 1. The user then applies a force to the chuck that overcomes this force and rotates the chuck to bring the bit into contact with the grinding wheel. Col. 8, lines 1-6.

It is therefore conclusive that Bernard '732 fails to disclose "a guide feature that maintains a longitudinal length of the bit along a predetermined axial line and at a predetermined angular orientation with respect to said line as said material is removed by the grinding wheel assembly." It is further conclusive that Bernard '732 fails to disclose "using the guide feature to maintain the bit in a first orientation while removing a first portion of said material" and "using the guide feature to maintain the bit in a second orientation that is 180 degrees opposite the first orientation with respect to the axial line while removing a second portion of said material." This is not surprising as the present

application is described as disclosing and claiming a patentable improvement over the point splitting operation of Bernard '732. See e.g., page 6, lines 6-20.

Accordingly, the Applicant respectfully submits that the first Office Action failed to establish a *prima facie* case of anticipation of independent claim 1 (as well as for the remaining rejected claims). Reconsideration and withdrawal of the rejection of claim 1, and for the claims depending therefrom, are respectfully solicited on this basis.

With regard to independent claim 7, Bernard '732 further at least fails to disclose "wherein the point-splitting port comprises a guide feature that maintains a longitudinal length of the bit along a predetermined axial line and at a constant angular orientation with respect to said line prior to and during the point-splitting operation." Instead, as set forth above, at best Bernard '732 discloses a guide feature that maintains a selected angular orientation prior to the point-splitting operation, but the guide feature does not maintain said angular orientation during the point splitting operation, as claimed.

Reconsideration and withdrawal of the rejection of independent claim 7, and for the claims depending therefrom, are accordingly solicited.

#### **Rejection of Claims Under 35 U.S.C. §103(a)**

Claims 13-18 were rejected as being rendered obvious over a combination of Bernard '732 and U.S. Patent No. 2,426,478 to Whipple ("Whipple '478"). This rejection is respectfully traversed.

First, the combination of references does not provide teachings or suggestions for all of the elements of claim 13. See MPEP 2143.03. The Examiner correctly notes that Bernard '732 fails to teach or suggest a collection tube that connects to the unused port.

However, Whipple '478 does not make up for this deficiency, as it likewise has a separate, dedicated attachment location and does not teach or suggest attaching the tube structure 88-90 to a port that can alternatively be used to sharpen the tool. This by itself presents a patentable contribution by the presently claimed subject matter.

Bernard '732 and Whipple '478 are further silent with regard to teaching or suggesting the recited vacuum attachment; Bernard '732 is silent with regard to debris handling, and Whipple '478 teaches forced airflow established by rotation of the wheel 27 as directing the debris to the collection assembly 88-90.

Finally, the Examiner has provided no evidence on the record that one skilled in the art would be motivated from these respective references to arrive at the claimed combination. Such evidence must be "clear and particular," and cannot be supported by mere conclusory statements. See *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999); MPEP 2143.01. There is nothing absent improper hindsight reconstruction to account for using a sharpening port and a vacuum, as provided by the Examiner in the rejection.

The Applicant therefore respectfully submits that the first Office Action failed to establish a *prima facie* case of obviousness for independent claim 13. Reconsideration and withdrawal of the rejection of claim 13, and for the claims depending therefrom, are respectfully requested on this basis.

#### Allowable Subject Matter

The Applicant gratefully acknowledges the indication of allowability of claims 3, 4, 9 and 10.

Conclusion

This is intended to be a complete response to the first Office Action mailed October 14, 2005. The Applicant respectfully requests reconsideration and allowance of all of the pending claims. Should any questions arise concerning this Response, the Examiner is invited to contact the below signed attorney.

Respectfully submitted,

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